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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,002	12/20/1999	PAUL NEGULESCU	AURO1130-2	3109

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EXAMINER

I. LANDSMAN, ROBERT S

ART UNIT PAPER NUMBER

1647

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/468,002

Applicant(s)

NEGULESCU ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66-70,74,78-80,84-88,93,97-101 and 105-150 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66-70,74,78-80,84-88,93,97-101 and 105-150 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Formal Matters

- A. The Amendment dated 5/27/04 has been entered into the record.
- B. Claims 66-70, 74, 78-80, 84-88, 93, 97-101 and 105-150 are pending in the application and are the subject of this Office Action.
- C. All Statutes under 35 USC not found in this Office Action can be found, cited in full, in a previous Office Action.

2. Claim Rejections - 35 USC § 112, second paragraph

- A. The rejection of claims 88, 101 and 109 under 35 USC 112, second paragraph, has been withdrawn in view of Applicants' amendments to the claims to delete the term "analog thereof."
- B. Claims 66-70, 74, 78-80, 84-88, 93, 97-101 and 105-150 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a control step which demonstrates that the ligand is acting via the GPCR of claims 139-145. This rejection has previously been made and withdrawn in view of Applicants' addition of dependent claims which recited that the methods were performed in the absence of the GPCR. However, after careful consideration, the addition of those dependent claims raises the question that this step is not required in the independent claims (139-145). Therefore, it is not clear how the artisan would be able to determine that the ligand was acting via the GPCR. In claim 139, for example, Applicants may want to consider something to the effect of adding "and comparing this expression to reporter gene expression in COS-7 cells comprising only (a), (b) and (d)." Furthermore, independent claims 139-145 need to recite a conclusion step which determines when the claimed method has been completed. For example, "wherein a change in reporter gene expression in the presence of a ligand indicates that the GPCR is a receptor for said ligand."
- C. Claim 145 is confusing since it is not clear what "function" is being profiled. All that is being measured is reporter gene activity. Therefore, it is not clear if this is the intended "function" to be measured, especially in the absence of a conclusion step as discussed in paragraph B above.

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3. Conclusion

A. No claim is allowable.

Due to the lengthy prosecution of this application, and the fact that it is close to allowable, Applicants may feel free to telephone the Examiner with any questions, or for the purpose of negotiating the claims to allowance.

Advisory information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961.

Official papers filed by fax should be directed to (703) 872-9306. Fax draft or informal communications with the examiner should be directed to (571) 273-0888.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0700.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
August 20, 2004


ROBERT LANDSMAN
PATENT EXAMINER